

## **REMARKS**

The Official Action dated May 13, 2004 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By the present Amendment, Claim 1 has been amended. Support for the amendment may be found at pages 12 and 17 of the specification. Since these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claims 1-6, 9, 10, 12-14, 16 and 19 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that antecedent support for a volumetric ratio of "greater than 4" was unclear. Antecedent support for the claim limitation "greater than 4" can be found on page 12, lines 15-18 which discloses volumetric ratios of "at least about 4". The limitation "at least about 4" inherently includes "about 4" and "greater than 4". As such the limitation "greater than 4" is a narrowing limitation of "at least about 4". As presently amended, the volumetric ratio claimed is "greater than 5". Support for "greater than 5" can be found in the limitation "at least about 4" on page 12 as well as the examples on pages 17 and 18 disclosing volumetric ratios of 5:1, 6:1, 7:1, 8:1 and 9:1. As such, Applicants believe that the claim limitation "greater than 5" is fully supported by the present specification and the Examiner's rejection has been overcome. Reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 1-6, 9, 10, 12-14, 16 and 17 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner asserted it was unclear whether the volumetric ratio of "greater than 4" would encompass amounts slightly less than exactly four as well as amounts greater than four. As explained during the

telephonic interview with the Examiner on July 27, 2004, the claim limitation "greater than 4" includes only volumetric ratios greater than 4. Moreover, by the present amendment, the claimed volumetric ratio has been limited to "greater than 5" which includes only volumetric ratios greater than five and does not include volumetric ratios of exactly five or less than five. As noted above, support for "greater than 5" can be found in the limitation "at least about 4" on page 12 as well as the examples on pages 17 and 18 disclosing volumetric ratios of 5:1, 6:1, 7:1, 8:1 and 9:1. As such, Applicants believe that the claim limitation "greater than 5" particularly points out and distinctly claims the subject matter which Applicants regard as the invention. Whereby, the Examiner's rejection has been overcome and reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 1-6, 9, 10, 12-14, 16 and 17 under 35 U.S.C. §103 as being unpatentable over Brown et al. (U.S. Patent No. 6,071,566). The Examiner asserted that Brown et al. teach applying a mixture of silanes to a metal substrate in order to facilitate subsequent application of a paint layer. The Examiner noted that Brown et al. do not exemplify Applicant's composition, but teach using a two component aqueous mixture. The Examiner asserted it would be expected that the aqueous mixtures of silanes of Brown et al. would inherently contain some partially hydrolyzed groups. The Examiner asserted it would have been obvious to one of ordinary skill in the art to utilize a mixture of bis (trimethoxysilylpropyl) amine and vinyl silane as disclosed by Brown et al in order to effectively treat a metal substrate.

However, as will be set forth in detail below, it is submitted that the methods of claims 1-6, 9, 10, and 12-14, 16 and 17 are non-obvious over and patentably distinguishable from the teachings of Brown et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Brown et al. fail to teach or suggest the silane ratio of the presently amended claim 1. Specifically, Brown et al. disclose that the ratio of vinyl silanes to multi-silyl-functional silanes ranges from 4:1 to 1:8. In contrast, the presently amended claims require that the ratio of vinyl silanes to bis-silyl aminosilanes is greater than 5 (claim 1).


To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1971). It is well settled that to support a rejection under 35 U.S.C. § 103(a), a reference must provide an enabling public disclosure, i.e., it must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). In view of the failure of Brown et al. to teach, disclose or suggest a ratio of vinyl silanes to bis-silyl aminosilane of greater than 5, Brown et al. do not support a rejection of claims 1-6, 9, 10, and 12-14, 16 and 17 under 35 U.S.C. §103. Reconsideration is respectfully requested.

Finally, Applicants wish to thank the Examiner for the telephonic interview on July 27, 2004. During the telephonic interview, Applicants' representative, Geoffrey Oberhaus, and the Examiner discussed support for the claim limitation "greater than 4" in the present specification. As discussed, support for the claim limitation "greater than 4" can inherently be found in the limitation "at least about 4". As such the limitation "greater than 4" is a narrowing limitation of "at least about 4". The Examiner agreed with the Applicant's argument regarding the limitation of "greater than 4" as being supported by "at least about 4". The Examiner and Applicants' representative then discussed the Brown et al. reference. Specifically, that Brown et al. only disclose ratios of vinyl silanes to multi-silyl-functional silanes ranges from 4:1 to 1:8. Applicants' representative proposed a claim amendment narrowing the scope of the present claims to a volumetric ratio of "greater than 5" which would clearly be outside of the ratios disclosed by Brown et al. The Examiner agreed with the support for the limitation of "greater than 5" and indicated that the limitation would

appear to overcome the rejection based on Brown et al., but the Examiner reserved the right to review the volumetric range disclosed by Brown et al.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§103 and 112, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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